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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/597,920	06/19/2000	Lawrence E. Samelson	NIH-05065	4586

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EXAMINER

HELMS, LARRY RONALD

ART UNIT	PAPER NUMBER
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1642

DATE MAILED: 04/27/2004

32

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/597,920

Applicant(s)

SAMELSON ET AL.

Examiner

Larry R. Helms

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 73-102 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 91-99, 101 and 102 is/are allowed.
- 6) ☒ Claim(s) 73-90 and 100 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Request for Continued Examination

1. The request filed on 3/2/04 for a Continued Examination (RCE) under 37 CFR 1.114 based on parent Application No. 09/597,920 is acceptable and a RCE has been established. Claims 73-102 are pending and are currently under prosecution. An action on the RCE follows.
2. Claims 74-76 have been amended.
Claims 85-102 have been added.
3. Claims 73-102 are under examination.
4. The text of those sections of Title 35 U.S.C. code not included in this office action can be found in a prior Office Action.
5. The following Office Action contains NEW GROUNDS of rejection .

Rejections Withdrawn

6. The rejection of claims 61-72 under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention is withdrawn in view of the amendments to the claims.

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7. The rejection of claims 74-77 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention is withdrawn in view of the amendments to the claims.

Response to Arguments

8. The rejection of claims 73-77, 79-82, 84 and newly added claims 85, 87-88, 90 under 35 U.S.C. 102(b) as being anticipated by Buday et al (The Journal of Biological Chemistry 269:9019-9023, 1994, IDS #5) and as evidenced from the specification is maintained.

The response filed 3/2/04 has been carefully considered but is deemed not to be persuasive. The response states that the claim term "specifically binds" which is interpreted by the examiner is contrary to the interpretation accorded by those skill in the art (see page 11 of response). In response to this argument, the specification does not define the phrase and as such the broadest interpretation is applied. In addition, applicants are directed to Roitt et al. (Immunology, third edition., Mosby, St. Louis, pages 6.4 and 6.5, 1993). Roitt teaches in the last sentence of the bridging paragraph of pages 6.4 and 6.5 that "when some of the determinants of an antigen, [for instance] A, are shared by another antigen, B, then a proportion of the antibodies directed to A will also react with B. This phenomenon is termed cross-reactivity." See Fig 6.8 on page 6.4. Furthermore, specificity is not equivocal to exclusivity. Roitt continues to

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state on page 6.5, column 2, second paragraph, "The specificity of a population of antibodies is not due to each antibody reacting exclusively with the induction antigen."

The response continues to state that there are at least 22 patents with this phrase and the proteins can exist in a phosphorylated state and if the art is maintained each of these patents should be invalid (see page 12 of response). In response to this argument, the examiner is not going to comment on the validity of a US patent. The rejection is maintained because Buday's antibody would be specific for SEQ ID NO:4. this is explained as follows, because the claims recite that the antibody is generated against a polypeptide comprising any 5 or 20 or residues 31-233 of SEQ ID NO:4 the antibody of Buday would recognizes the phosphotyrosine in SEQ ID NO:4 which can be generated against the entire protein (comprising) or any residues that contain the phosphotyrosine residue. If the entire protein was used as an immunogen or any fragment that has the phosphotyrosine residue, antibodies can be generated that bind the phosphotyrosine residue, such as Buday's. In addition, because the antigen is in 293T cells the antibody of Buday would bind. Also one would readily envisage that the antibody would not stain endothelial cells because the antigen is not found there. Thus, the art reads on the claims.

9. The rejection of claims 73-78, 80-83, and newly added claims 85-86, 88-89 under 35 U.S.C. 102(e) as being anticipated by Hirth et al (U.S. Patent 5,958,959, filed 6/1/95) is maintained.

The response filed 3/2/04 has been carefully considered but is deemed not to be persuasive. The response states that the claim term "specifically binds" which is interpreted by the examiner is contrary to the interpretation accorded by those skill in the art (see page 11 of response). In response to this argument, the specification does not define the phrase and as such the broadest interpretation is applied. In addition, applicants are directed to Roitt et al. (Immunology, third edition., Mosby, St. Louis, pages 6.4 and 6.5, 1993). Roitt teaches in the last sentence of the bridging paragraph of pages 6.4 and 6.5 that "when some of the determinants of an antigen, [for instance] A, are shared by another antigen, B, then a proportion of the antibodies directed to A will also react with B. This phenomenon is termed cross-reactivity." See Fig 6.8 on page 6.4. Furthermore, specificity is not equivocal to exclusivity. Roitt continues to state on page 6.5, column 2, second paragraph, "The specificity of a population of antibodies is not due to each antibody reacting exclusively with the induction antigen."

The response continues to state that there are at least 22 patents with this phrase and the proteins can exist in a phosphorylated state and if the art is maintained each of these patents should be invalid (see page 12 of response). In response to this argument, the examiner is not going to comment on the validity of a US patent. Hirth's antibody would be specific for SEQ ID NO:4. This is explained as follows, because the claims recite that the antibody is generated against a polypeptide comprising any 5 or 20 or residues 31-233 of SEQ ID NO:4 the antibody of Hirth would recognize the phosphotyrosine in SEQ ID NO:4 which can be generated against the entire protein (comprising) or any residues that contain the phosphotyrosine residue. If the entire

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protein was used as an immunogen or any fragment that has the phosphotyrosine residue, antibodies can be generated that bind the phosphotyrosine residue, such as Hirth's. In addition, because the antigen is in 293T cells the antibody of Hirth would bind. Also one would readily envisage that the antibody would not stain endothelial cells because the antigen is not found there. Thus, the art reads on the claims.

The following are NEW GROUNDS of rejection

Claim Rejections - 35 USC § 112

10. Claims 81, 83-90 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 81 and those depended from claim 81 are indefinite for reciting "polypeptide comprising at least five amino acids comprises at least about 20 amino acids" in claim 81 because it is not clear if the polypeptide comprises 5 or 20 amino acids.

11. Claims 85-87, 100 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to

one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. This is a new matter rejection.

Claims 85 and 100 have been amended to recite "wherein the antibody immunoprecipitates a 40 kd protein from a lysate of 293T cells transfected with LAT cDNA". Support is states in the response filed 3/2/04 as being in Figure 2B. Figure 2B shows a an immunoblot of lysates from C305 cells (see page 7, line 18-21). The figure does not have 293T cells. In addition, Figure 2A shows 293T cells but are detected with an anti-myc antibody not an anti-LAT antibody. Therefore, there appears to be no support in the specification as originally filed for the limitation. Applicant is required to provide specific support for the claimed limitation or remove it from the claims.

Conclusion

12. Claims 91-99, 101-102 are in condition for allowance.
16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Larry R. Helms, Ph.D, whose telephone number is (571) 272-0832. The examiner can normally be reached on Monday through Friday from 7:00 am to 4:30 pm, with alternate Fridays off. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne Eyler, can be reached at (571) 272-0871.
17. Papers related to this application may be submitted to Group 1600 by facsimile transmission. Papers should be faxed to Group 1600 via the PTO Fax Center. The

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faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The Fax Center telephone number is 703-872-9306.

Respectfully,

Larry R. Helms Ph.D.

571-272-0832



LARRY R. HELMS, PH.D.
PRIMARY EXAMINER